

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. This amendment and response is being filed within the shortened statutory period and within TWO MONTHS from the mailing date of the Official Action. No fees are believed due in connection with this response.

Claims 1-22 remain pending in the instant application.

Claims 1, 8, 13 and 21 have been amended in response to the objection raised in the Official Action. Support for the amendments is found for example in paragraphs [0007], [0010], [0015], [0039], [0041] and other locations throughout the specification. The amendments to the claims emphasize that the invention is intended to be a prepackaged item that is delivered to families or small groups in response to a request for such a package for use in various types of outings or gatherings.

Claims 1, 7, 8 and 13-21 have been rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Riley (US 6,748,687). Reconsideration and withdraw of the rejection is earnestly solicited as Riley does not anticipate claims 1, 8 or 13 as amended and claim 21 as previously presented as each and every element is not present in the single prior art reference.

The standard of review under this section 102 is well founded and in this regard see, Kalman v. Kimberly-Clark Corp., 713 F. 2d 760, at 771, 218 USPQ 781, at 789 (1983), where the Court of Appeals for the Federal Circuit held:

“A party asserting that a patent claim is anticipated under 35 USC 102 must demonstrate, among other things, identity of invention. In cases like this, identity of invention is a question of fact... (citation omitted) and one who seeks such

a finding must show that each element of the claim in issue is found, either expressly described or under the principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice.”

Claims 1, 8 and 13 have been amended to indicate that a package is prepared and delivered to a family or a small group in response to a request for such an item. Claim 21 as previously presented already contained this limitation as well as others that are simply not found in the Riley reference, such as the existence of collateral marketing material. In fact, the Official Action is silent with respect to the limitations that are contained in claim 21.

Riley discloses a particular form construction that is used in a hospital for identification, such as in the case of a pregnancy, where members of the immediate family (mother, father, infant) may be identified for security purposes. An individual form is prepared by a hospital admitting clerk and the removable portion(s) provided to the parents upon admission of the mother to the hospital.

Riley does not discuss or disclose a package that is requested in advance of an activity by a family or a small group. Nor could the disclosure of Riley be modified to suggest such an arrangement as the form product of Riley is printed at the time of admission for security reasons and in all likelihood, a hospital would not accept a number of previously prepared wristbands due to such security reasons and the need to independently verify each member of the group. See for example, column 4, lines 30-40, where Riley describes some of the security issues relating to hospital admittance and instances “where two babies were switched at birth” (column 4, line 39). Thus, the disclosure of Riley specifically teaches away from providing a package of identification

bands for use by families or groups as the invention described in Riley “virtually eliminates” (column 4, line 44) the security problems associated with bands.

Riley also does not disclose the creation of a package of wristbands for use in an outing as required by now amended claims 8 and 13, or the step of creating marketing collateral targeted at the family or group as required by claim 21 or the presence of marketing collateral in the package as now required by amended claim 1.

Claims 2-6, 9-12 and 22 have been rejected by the Examiner under 35 U.S.C. 103(a) as obvious over Riley in view of Mullins et al (US2004/0056088). Reconsideration and withdraw of the rejection is earnestly solicited as the combination of references fails to teach or suggest the required limitations of the claims as amended and as previously presented.

The Examiner has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Three criteria must be satisfied to establish a *prima facie* case of obviousness. First, the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would teach, suggest, or motivate one to modify a reference or to combine the teachings of multiple references. *Id.* Second, the prior art can be modified or combined only so long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Third, the prior art reference or combined prior art references must teach or suggest all of the claim limitations. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

Mullins et al relate to a generic point of sale or debit band product in which a customer deposits funds with an amusement park and the accounting system then records the sum, such that each time the bar code on the band is scanned, sums are deducted. The band is not personalized nor does it contain information relating to the identity of a particular individual, nor is the product used to identify a family or group that is participating in a particular outing. The band is also not provided as part of a larger package. The band simply contains information relating to a monetary value assigned to a particular coded reference. Thus, Mullins et al cannot be used to teach a package for creating personalized identification bands in combination with Riley as Mullins et al provide a generic, point of sale product used only for assigning monetary value and fails the first test as required above.

The band disclosed in Mullins et al is not used to identify members of a group, which is required by the independent claims, nor is there any suggestion to provide a package of such bands along with software so that recipients of the package can print personalized information relating to each participant in the group. It is unlikely that an amusement park would be willing distribute packages of bands that would enable users to freely encode amounts onto the band as such a situation may subject the amusement park to a loss of control, possible fraud and other difficulties with having unregulated systems.

In addition, Mullins et al do not teach the presence of marketing collateral as required by the independent claims, both as amended and as previously presented. There is no disclosure or suggestion in Mullins et al concerning providing marketing materials as required by claim 9; promotional offers as required in claim 10; decorative labels in the package as required in claim 11; or inserting promotional offers as required by claim 22. The combination thus does not suggest or teach all of the required limitations of the claims and fails at least the third test as set forth above.

Mullins et al do not remedy the deficiencies in Riley, nor could Riley be so modified as suggested in the Official Action as it is highly unlikely that at the time of a hospital admission for a pregnancy which is the stated purpose of Riley, that expectant parents would want or would even tolerate being presented with promotional offers, marketing materials and the like when facing an exigent situation, such as the birth of a child.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited. The Examiner is encouraged to contact the undersigned in the event any small matters remaining outstanding so as to eliminate the necessity of another action and response.

Respectfully submitted,



Michael C. Maier
Reg. No. 36,206

P.O. Box 938
2401 Cooper Street
Fort Scott, KS 66701
(620) 223-5500 x4250